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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,018	05/19/2006	Johannes Bos	127898	7546
25944 7590 04/28/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
LISTVOYB, GREGORY				
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1796				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/580,018

**Applicant(s)**

BOS, JOHANNES

**Examiner**

GREGORY LISTVOYB

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 rejected under 35 U.S.C. 103(a) as being unpatentable over  
Chernykh et al (RU 2017866) herein Chernykh or Jung et al (US 5646234) herein Jung  
in combination with Encyclopedia of Pol. Sci and Tech (Polyamides, vol 3, p. 565-567)  
herein Encyclopedia and the Applicant's admission of the Prior Art in the Specification.

Chernykh discloses a method for obtaining a composition comprising an aromatic  
polyamide containing para- phenylene terephthalamide and 2-(p-

phenylene)benzimidazole terephthalamide units by copolymerizing: i) a= 10-80  
mole % of para-phenylenediamine; ii) b=10-80 mole % of 5(6)-amino-2-(p-  
aminophenyl)benzimidazole; and iii) 100 mole% of terephthaloyl dichloride (see  
Example 1).

Note that in the Example 1 Chernykh uses Cl-para-phenylenediamine, whereas  
Claim 1 claims para-phenylenediamine. However, Chernykh teaches that the above  
compounds are equivalent (see Page 7, line 15).

Also, Chernykh teaches that DMAA and NMP as well as LiCl or CaCl<sub>2</sub> can be equally used (see Page 3, line 25).

in a mixture of N-methyl pyrrolidone and containing 2.8-4.8% wt.% of calcium chloride or lithium chloride (see Table 2, column 2), a + b is 100 mole% and i), ii), and iii) together comprise 1-20 wt.% of the mixture (see Example 1), Based on the above data the result of b x c multiplication can be less than 215.

Intrinsic viscosity of the polymer above is between 5.9 and 10.9 dl/g (see Table 2).

Jung discloses method of obtaining an aramid by polycondensation of 100 mol% terephthaloyl chloride, 40 mol% p-phenylenediamine and 60 mol% 5(6)-amino-2-(p-aminophenyl)-benzimidazole in N-methylpyrrolidone, wherein a+b=100 mol% and the relative viscosity is 4,3 (see example 8).

Jung discloses solubility-promoting additives such as calcium dichloride in amounts of between 0,2 and 10 wt.%, preferably between 0,5 and 5 wt.%, can be added to the polycondensator mixture (see column 3, lines 19-35 and 62-67).

Chernykh or Jung do not disclose a crumb, since their processes are intended to directly process a solution into article immediately after synthesis.

Regarding Claims 4 and 5, Encyclopedia discloses a process of obtaining Poly(p-phenylene terephthalamide) in of N-methyl pyrrolidone at the presence of Calcium Chloride. Encyclopedia teaches a process for making a purified aromatic polyamide, which comprises coagulating and washing the crumb in water, followed by drying step (see pages 565 and 567).

Chernykh or Jung do not teach the polymer precipitation step, since synthesis of polymer and its processing locates in one facility. However, more commonly those two processes are separated. In this case it is economically efficient to transport and store dried polymer instead of its diluted solution in N-methyl pyrrolidone.

Therefore, it would have been obvious to a person of ordinary skills in the art to precipitate Chernykh's or Jung's polymer using Encyclopedia's technology in Order to expand applicability of the polyamide.

Chernykh or Jung and Encyclopedia does not disclose the crumb is defined as non-sticky particles at least 95% of which having an average diameter of 0.7-15 mm.

However, according to Applicant's discussion of the Prior Art in the Specification, such crumbs are known from the process of preparing of fully aromatic polyamides based on e.g. PPD and TDC, which products are known under the trade names Twaron® (Teijin Twaron) and Kevlar (DuPont). After polymerization in NMP/CaCl<sub>2</sub> a crumb is obtained which can be easily coagulated, washed, and dried, and the product

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obtained can be dissolved in sulfuric acid and shaped into a desired form, like fibers or films.

The crumbs of the above particles are very process-friendly, in particular, in a filtration step. The efficiency of the above step can be impaired with fines or sticky gels. Polymer precipitation aiming the crumbs with particular particle size can be achieved with well known technological approaches (rate of precipitant adding, temperature, stirring, etc).

Therefore, it would have been obvious to a person of ordinary skills in the art to obtain crumb with optimum particle size (i.e. 0.7-15 mm) in order to achieve efficient filtration process.

It is noted that there is no showing of unexpected results, associated with particular particle size range in the Specification.

### ***Response to Arguments***

Applicant's arguments filed 2/11/2008 have been fully considered but they are not persuasive.

The Applicant argues that Chernykh or Jung do not disclose a crumb. However, as asserted in the previous Office Action, Chernykh or Jung do not teach the polymer precipitation step, since synthesis of polymer and its processing locates in one facility. However, more commonly those two processes are separated. In this case it is economically efficient to transport and store dried polymer instead of its diluted solution in N-methyl pyrrolidone.

The Applicant argues that Encyclopedia does not teach or suggest replacing a portion of the PPD with 5(6)-amino-2-(p-aminophenyl)-benzimidazole ("DAPBI"). However, Encyclopedia cited in the Rejection solely for teaching a common commercial process for making a purified aromatic polyamide, which comprises coagulating and washing the crumb in water, followed by drying step (see pages 565 and 567). The difference in a polymeric structure dictates changing the ratio between "good" and "bad" solvents, which is within the knowledge of the person of ordinary skills in the art.

The Applicant argues that Example 1 of Chernykh discloses (1) a different phenylenediamine (C1-PPD vs. PPD), (2) a different salt (lithium chloride v. calcium chloride) and (3) a different solvent (DMAC v. NMP) than required in claim 2 in order to obtain a crumb form of the composition. However, Chernykh teaches that the above compounds are equivalent (see Page 7, line 15). Also, Chernykh teaches that DMAA and NMP as well as LiCl or CaCl<sub>2</sub> can be equally used (see Page 3, line 25).

In the instant case substitution of equivalent methods requires no express motivation, as long as the prior art recognizes equivalency, *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. V. Linde Air products Co.* 85 USPQ 328 (USSC 1950)

The Applicant argues that in Example 9 of Chernykh, the product of b and c in Example 9 is 288 and is thus outside of the upper limit of 215 recited in Claim 1. However, as discussed above, the ratio between polymer and precipitant is a technological parameter, which is within the artisan's knowledge.

The Applicant argues that Example 1 of Jung does not disclose the solvent mixture of NMP and calcium chloride, but the single solvent NMP.

However, Jung discloses solubility-promoting additives such as calcium dichloride in amounts of between 0,2 and 10 wt.%, preferably between 0,5 and 5 wt.%, can be added to the polycondensator mixture (see column 3, lines 19-35 and 62-67).

According to MPEP 2123, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments (see also *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971), *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994), *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).



Regarding the Applicant's argument that Jung does not have the exact ratios as claimed in Claim 1, as discussed above, the ratio between polymer and precipitant is a technological parameter, which is within the artisan's knowledge.

The Applicant's argues that Gibbs-Roseboom Phase Triangle ("Phase Triangle") can not determine the state of a precipitated polymer (gel, fine powder or crumb). This is correct. The Phase Diagram builds to determine areas of solid-liquid equilibrium of the polymer composition. It is typically prepared in a lab before performing any plant process. The precipitate consistency routinely examines by an artisan.

The above equilibrium depends on the polymer structure, solvent/non-solvent ratio, temperature and molecular weight of the polymer. For instance, Claim 1 of the Application determines molecular weight as "relative viscosity of at least 4", which is not sufficient to prepare composition in a large scale, since the system behavior could be unpredictable. Also, process's temperature is not defined at all. Therefore, determination of such technological parameters as the ratio between solvent and non-solvent and a polymer concentration (i.e. building at least a fragment of a phase diagram) is absolutely necessary for the process implementation.

The Applicant states that "The Patent Office's reasoning, as advanced during the interview, is clearly impermissible hindsight as it is based on one knowing what

materials to use together and then evaluating which concentrations yield a crumb, neither of which is taught or suggested in the cited references".

Examiner did not suggest that mixing polymer and solvent together yield a crumb. The Encyclopedia clearly teaches the crumb forming in a similar composition. The motivation to prepare a crumb, compare to fine powder or gel precipitate was discussed above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY LISTVOYB whose telephone number is (571)272-6105. The examiner can normally be reached on 10am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rabon Sergent/  
Primary Examiner, Art Unit 1796

GL  
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